

REMARKS

The Applicants elect with traverse claims 1-29 directed to gene-encoded beta-catenin. Claims 1-29 are generic. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

PRACTICE RE NUCLEOTIDE SEQUENCES

MPEP §803.04 states, “to further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office, the Director has decided *sua sponte* to partially waive the requirements of 37 CFR 1.141 *et seq.* and permit a reasonable number of such nucleotide sequences to be claimed in a single application. See Examination of Patent Applications Containing Nucleotide Sequences, 1192 O.G. 68 (November 19, 1996).”

“It has been determined that normally **ten sequences constitute a reasonable number** for examination purposes. Accordingly, in most cases, up to ten independent and distinct nucleotide sequences will be examined in a single application without restriction. ...”
Ibid.

Examination of a gene-encoded beta-catenin; a gene-encoded alpha-catenin; and a gene-encoded E-cadherin would not place undue burden upon the examiner. Beta-catenin; alpha-catenin; and E-cadherin are beta-catenin associated proteins. Alpha-catenin and E-cadherin both bind to beta-catenin and are similarly expressed in cancerous tissues. Additionally, restricting these genes independently would place an undue burden on the Applicant requiring multiple application, prosecution, issue and maintenance fees.

PRACTICE RE MARKUSH-TYPE CLAIMS

MPEP §803.02 states, “If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made **without serious burden**, the Examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions. In such a case, the Examiner will not follow the procedure described below and will not require

restriction.” Applicants respectfully note that beta-catenin; alpha-catenin; and E-cadherin are beta-catenin associated proteins and are similarly expressed in cancerous tissues.

Additionally, MPEP §803.02 states, “the Examiner may require a **provisional election** of a single species prior to examination on the merits.” Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue. No fees are believed due with this submission. The response is due August 5, 2007. Monday, August 06, 2007 is the first business day after August 5, 2007. If fees are required, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Deposit Account No. 50-3420, reference 32144183-000004 (MDB).

Dated: August 6, 2007

Respectfully submitted,

By Michael D Berger #52616/
Michael D. Berger, Ph.D.

Registration No.: 52,616
BAKER & MCKENZIE LLP
Pennzoil Place, South Tower
711 Louisiana, Suite 3400
Houston, TX 77002-2746
(713) 951-3300
(713) 951-3314 (Fax)